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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,291	02/11/2002	Patrice J. McCune	MA-12918	2439

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EXAMINER

VO, HAI

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,291

Applicant(s)

MCCUNE, PATRICE J.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1, 2, 5, 6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Claims 3, 4, 7 and 16-31 have been canceled in the amendment received on 05/12/2003.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 8, 9 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alderfer (US 3,223,568). Alderfer teaches a composite sheet that may be wound or coiled for storage or shipment (column 1, lines 30-32). Likewise, it is apparent that the composite sheet is flexible. Alderfer teaches a composite sheet formed from a resilient foam material having a defined cellular structure and structural integrity (column 1, lines 67-70). Alderfer teaches infra red or heat lamps being used for thermally softening the film to ensure uniform adherence of the film to the foam

(column 3, lines 50-56). Alderfer teaches the film bonded to the foam layer by an adhesive (column 3, lines 57-60). Since composition of the primer is not defined in the claim, the adhesive of Alderfer is interpreted as Applicant's primer. It appears that Alderfer and Applicant is using polyurethane to form a foam layer (Alderfer, column 3, line 21 vs. Applicant's specification, page 6, line 5). Since Applicant states that the foam material should be non-reactive, free of plasticizers and have a non-slid bottom surface and polyurethane foam is one of suitable materials to fit the characteristics (page 6, lines 5-10), the polyurethane foam of Alderfer would inherently exhibit the same properties as described in Applicant's specification. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990). Products of identical chemical composition can not have mutually exclusive properties.

Alderfer does not specifically disclose the foam layer cast on the film as recited in the claim. However, It is the examiner's position that the article of Alderfer is identical to or slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (foam/film laminate). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227

USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The Alderfer reference anticipates or strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Alderfer.

The foam/film laminate of Alderfer appears to be structurally the same and made of the same materials as Applicant's sheet material. The foam/film laminate of Alderfer happens to be a resilient, flexible and non-adhesive material wherein both the polyolefin top film and the foam layer are continuous and have uniform thickness as required by the claims. It is the examiner's position that the curl resistance of the foam/film laminate would be inherently present. Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (Note discussion found in *Ex parte Slob*, 157 USPQ 172). It is the examiner's position that Alderfer anticipates or strongly suggests the claimed subject matter.

5. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alderfer (US 3,223,568) substantially as set forth in Paper no. 5.
6. Claims 5, 6, 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alderfer (US 3,223,568) as applied to claim 1 above, and further in view of Hartzell et al (US 3,713,925) substantially as set forth in Paper no. 5. Alderfer discloses the foam layer made of polyurethane or polystyrene (column 2, lines 5 and 9). Alderfer does not specifically disclose the foam layer of a styrene butadiene foam. Hartzell teaches a composite material useful as protective coverings comprising a foam layer and a plastic coating applied to the foam layer (column 1, lines 10-16, and 42). Hartzell teaches the foam layer made of a rubber foam or a styrene butadiene foam (column 2, lines 10-12) to impart resilience and flexibility of the products (column 2, lines 25-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the polystyrene foam by a styrene butadiene foam motivated by the desire to impart added resilience and flexibility of the composite material, which is important to the invention of Alderfer, further suggesting the modification.

With regard to claim 13, it appears that Alderfer/Hartzell and Applicant are using a styrene butadiene foam to form a foam layer (Hartzell, column 2, line 11 vs. Applicant's specification, page 5, line 19). Since Applicant states that the foam material should be non-reactive, free of plasticizers and have a non-slid bottom surface and styrene butadiene foam is one of suitable materials to fit the

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characteristics (page 6, lines 5-10), the styrene butadiene foam of Alderfer/Hartzell would inherently exhibit the same properties as described in Applicant's specification. This is in line with *In re Spada*, 15 USPQ 2d 1655 (1990). Products of identical chemical composition can not have mutually exclusive properties.

With regard to claim 14, Alderfer teaches a film layer having a thickness of 10 mils. However, Applicant does not provide criticality of the thickness of the film layer. The examiner believes that such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product. In an absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam layer having the thickness instantly claimed to impart the cushioning effect of the laminate and the adherence between the foam and the film layers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

7. Applicant's amendments filed on 05/08/2003 have been entered and carefully considered.
8. The art rejections over Hawley have been overcome because Hawley fails to teach a thin polyolefin top film adjacent to and adhered to a foam layer.

9. The art rejections over Breitscheidel have been overcome by the present amendment and argument. Breitscheidel teaches a panel for use as automotive body panels which is not flexible but rather rigid or semi-rigid structure as Applicant claims (see page 8 of Applicant's amendment, Paper no. 6). Further, a composite sheet of Breitscheidel is shaped during application onto the automobile body parts, one skilled on in the art would not be motivated to use the panel of Breitscheidel for the shelf liner or household covering.
10. The art rejections over Neuhaus have been overcome by the present amendment and argument. Nothing in Neuhaus teaches or suggests a polyolefin top film adjacent to and adhere a foam layer.
11. The 102 art rejections over Alderfer have been maintained for the following reasons. In the first place, Alderfer teaches a composite sheet that may be wound or coiled for storage or shipment (column 1, lines 30-32). Likewise, it is apparent that the composite sheet is flexible. Secondly, Alderfer teaches a composite sheet formed from a resilient foam material having a defined cellular structure and structural integrity (column 1, lines 67-70). Finally, the arguments that the structure created in Alderfer reference will inherently be curly because the melted side of the film is brought into contact with a large cylindrical foam body are not found persuasive. The examiner absolutely agrees that the cylindrical foam body itself would have a great tendency to curl resulting from the cutting process. However, the composite structure of the foam/film layer would not necessarily curl upon the heat lamination. The foam/film laminate of Alderfer

appears to be structurally the same and made of the same materials as Applicant's sheet material. The foam/film laminate of Alderfer happens to be a resilient, flexible and non-adhesive material wherein both the polyolefin top film and the foam layer are continuous and have uniform thickness as required by the claims. It is the examiner's position that the curl resistance of the foam/film laminate would be inherently present. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (Note discussion found in Ex parte Slob, 157 USPQ 172).

12. The art rejections over Alderfer in view of Hartzell have been maintained for following reasons. The arguments that there is no reason for one seeking to laminate foam onto film to look to Hartzell which is laminating foam onto asbestos paper are not found persuasive. Hartzell reference does not exclude an embodiment wherein a composite sheet material useful as protective coverings is composed of a foam layer and a plastic coating adhered to the foam layer (column 1, lines 10-16, and 42). Alderfer discloses the foam layer made of polyurethane or polystyrene (column 2, lines 5 and 9). Alderfer is silent as the foam layer of a styrene butadiene foam. Hartzell teaches the foam layer made of a rubber foam or a styrene butadiene foam (column 2, lines 10-12) to impart added resilience and flexibility of the products (column 2, lines 25-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the polystyrene foam by a styrene butadiene foam motivated by the desire to impart added resilience and flexibility of the composite material,

which is important to the invention of Alderfer, further suggesting the modification. Further, Applicant argues that neither reference is addressing the curl problem and a foam directly being cast on the film. They are not found persuasive. The curl resistance has been inherently included in Alderfer reference. The foam/film laminate of Alderfer appears to be structurally the same and made of the same materials as Applicant's sheet material. The foam/film laminate of Alderfer happens to be a resilient, flexible and non-adhesive material wherein both the polyolefin top film and the foam layer are continuous and have uniform thickness as required by the claims. It is the examiner's position that the curl resistance of the foam/film laminate would be inherently present. It seems from the claim, if one meets the structure recited, the properties must be met or Applicant's claim is incomplete (Note discussion found in Ex parte Slob, 157 USPQ 172).

Alderfer/Hartzell does not specifically disclose the foam layer cast on the film as recited in the claim. However, It is the examiner's position that the article of Alderfer/Hartzell is identical to or slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (foam/film laminate). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior

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art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). The Alderfer/Hartzell reference anticipates or strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Alderfer/Hartzell.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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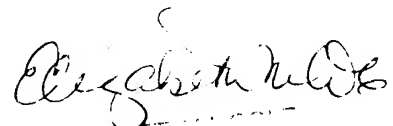
the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
July 22, 2003


ELIZABETH H. H. H.
PRIN